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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,355	04/11/2006	Sheng Mei Shen	P29756	3521

52123 7590 10/03/2008  
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EXAMINER
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MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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10/03/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,355	<b>Applicant(s)</b> SHEN ET AL.	
	<b>Examiner</b> JOSHUA MURDOUGH	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/2006, 8/4/2006</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is responsive to Applicants' preliminary amendment received 28 June 2006 and the IDS filed 4 August 2006.
2. Claims 1-10 are pending and have been examined.

### ***Information Disclosure Statement***

3. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 C.F.R. §1.98. 37 C.F.R. §1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 C.F.R. §1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 C.F.R. §1.97(e). See MPEP § 609.05(a).

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4. Applicants indicate that several of the crossed out references have been provided to the Office. However, the Examiner cannot find them in the electronic file wrapper. If Applicants resubmit these documents, the Examiner will consider them.

### ***Claim Objections***

5. Claims 1-10 are objected to because of the following informalities:

- a. Claim 1, line 3, recites “processing the content to protect copyright of the content.” This does not make grammatical sense. The Examiner suggests amending it to read “...to protect a copyright on the content,” in order to keep the meaning of the limitation but clear up the grammar issue.
- b. Claim 3, lines 3-4 recite “information of a first protect canceling tool.” This does not make grammatical sense. The Examiner suggests changing "protect" to "protection" in order to keep the meaning of the limitation but clear up the grammar issue.
- c. Claim 4, line 4 recites “making digital signature in the content.” This does not make grammatical sense. The Examiner suggests adding “a” between “making” and “digital” in order to keep the meaning of the limitation but clear up the grammar issue.
- d. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

e. Claim 1 uses the phrase “a form of Digital Item Declaration” (“DID”) in at least line 6. However, Digital Item Declaration Language (DIDL) is an XML dialect standardized in MPEG-21. Thus, one of ordinary skill in the art would not understand what “a form of DID” would encompass. Furthermore, Applicants’ description, while providing examples of what may be contained in the DID, falls short of defining what the form of DID is in a clear and precise manner. See MPEP 2173.02.

f. Claim 1 recites the limitation “describing a first digital item or a second digital item in which said first digital item is defined in a form of Digital Item Declaration” in lines 5-6. One of ordinary skill in the art would not understand whether Applicants intended this limitation to set out "a first digital item" and "a second digital item in which said first digital item is defined in a form of Digital Item Declaration" or "a first digital item" and "a second digital item" with “in which said first digital item is defined in a form of Digital Item Declaration” being separate. The Examiner has used the first interpretation when applying the prior art. However, if the second interpretation is the intended one, Applicants are encouraged to use punctuation, such as a comma, between “item” and “in.” Applicants are also advised that this interpretation gives rise to issues if it is describing a second digital item, such as: Is the first digital item still present? Applicants' use of "or" suggests that it is not. Is the second digital item intended to be

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modified by the other limitations if that is the case? As currently recited, this would not be the interpretation.

g. The present interpretation also gives rise to other issues. In lines 9-10, the claim recites “packaging said first or second digital item described in the form of Digital Item Declaration.” The first digital item is only defined in a form of Digital Item Declaration if it is in the second digital item and the second digital item is never shown to be defined in a form of Digital Item Declaration. Therefore, this limitation lacks antecedent basis for any case other than the second digital item being selected at the first “or” and the first digital item being selected at the second “or.”

h. Also in claim 1, the steps taken for the limitation “packaging said first or second digital item described in the form of Digital Item Declaration” in lines 9-10, would not be known to one of ordinary skill in the art for the case where the item is already in the form of DID, such as the first item.

i. Further in regards to claim 1, lines 6-8, the recitation of “said first digital item containing the content or an address of the content and being able to contain other digital items defined therein” does not show where the therein is referring to. If it is referring to the address, there is another issue with antecedent basis, as the address is not necessarily present because of the “or,” which allows just the content to be present.

j. Claim 4 recites “one of a set of a flag” multiple times. One of ordinary skill in the art would not be able to determine if this is supposed to be “one of a set of flags,” if so, if the set is only supposed to have one flag in it, or if this limitation is supposed to be setting a flag.

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k. Claim 4 also recites “a flag which indicates that the digital watermarking is embedded in the content and information of a detection tool for detecting the digital watermarking” in lines 7-8. A flag is usually a single bit of data, therefore, one of ordinary skill in the art would not understand how a flag can indicate information of a detection tool.

l. Claim 4 also recites “a flag which indicates that the content is encrypted and information of a decryption tool for decrypting the encrypted content” in lines 9-10. A flag is usually a single bit of data, therefore, one of ordinary skill in the art would not understand how a flag can indicate information of a decryption tool.

m. Claim 4 also recites “flag which indicates that the digital signature is made in the content and information of a checking tool for checking the digital signature” in lines 9-10. A flag is usually a single bit of data, therefore, one of ordinary skill in the art would not understand how a flag can indicate information of a checking tool.

n. It is unclear how this Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: how “information of a second protect canceling tool for canceling the protection of the copyright of said second description” in lines 6-7 relates to the claimed system. In its current state, it appears to be non-functional descriptive material and has been interpreted as such when the art was applied.

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o. Claim 10 recites “wherein said content processor processes said second description to protect copyright of said second description” in lines 2-3. As described in claim 8, from which claim 10 is dependent, the second description is directed toward use conditions not a copyright. Therefore one of ordinary skill in the art would not understand the scope of the descriptions.

8. In some cases, the Examiner omitted redundant rejections to the same limitations in the same or different claims. Applicants are requested to review all of the claims for the same language and make the appropriate changes throughout.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-10, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter (US 5,892,900) in view of Chang (US 2002/0138495).

11. As to claim 1, Ginter shows:

p. A method for delivering content (Figure 2), comprising:

q. processing the content to protect copyright (Columns 14-15, lines 49-9) of the content **304**;

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- r. deciding use conditions of the content **308**;
  - s. describing **804** a first digital item **880**,
  - t. said first digital item containing the content (Figure 20, within container 300) or an address of the content and being able to contain other digital items defined therein (Figure 20, Content 812a-n);
  - u. packaging said first digital item (in container **300**); and
  - v. delivering said first digital item packaged in said packaging-step (Figure 2A) to a user terminal **112**;
  - w. wherein, in said describing step, a first description regarding processing the content to protect the copyright of the content (Columns 14-15, lines 49-9) and a second description regarding the use conditions (Figure 5B, **308**, Limitations On Activities) are both described in said first digital item.
12. Ginter does not expressly show:
- The first digital item is described in the form of Digital Item Declaration
13. However, Chang shows a digital item in Digital Item Definition Language (“DIDL”) ([0013] and Figure 1) containing a Declaration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ginter to substitute the DIDL structure for the generic structure of Ginter in order to “provide a method for configuring a digital item using the condition that corresponds to a user determined precedence of the selection” [0027].

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14. As to claim 2, Ginter further shows:

wherein said second description is described followed by said first description in said first digital item, so that said second description is analyzed ahead of said first description by the user terminal (objects or items are allowed to be nested, or placed inside of each other, thus requiring for the descriptions to be analyzed in order; Columns 299-300, lines 60-6).

As to claim 3, the describing of a flag and information of a first product cancelling tool are non-functional, as the data is not positively shown as being used. Therefore, the method where multiple pieces of information can be stored as shown in reference to claim 1, also renders this claim obvious.

15. As to claim 4, Ginter further shows:

wherein said processing comprises at least one of embedding digital watermarking in the content (Columns 37-38, lines 15-35), encrypting the content (Column 9, lines 19-32), and making digital signature in the content (Columns 21-22, lines 60-25),

As each of these types of processing are shown, there necessarily has to be a way of detecting each of them, a flag, and a tool for the use of them.

16. As to claim 5, Ginter further shows:

x. wherein said processing comprises encrypting the content with a use of an encryption key (a key is inherent to any encryption), and

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- y. wherein said describing comprises describing a flag which indicates that the content is encrypted, the information of a decryption tool for decrypting the encrypted content, and information of the encryption key, as said first description (Column 9, lines 19-32).
17. As to claim 6, Ginter further shows:
- z. wherein said processing-step further comprises a step of encrypting the encryption key (Column 222, lines 40-48), and
  - aa. wherein said describing-step further comprises a step of describing information of a license key for decrypting the encrypted encryption key (Column 222, lines 40-48).
18. As to claim 7, Ginter further shows:
- bb. processing said second description to protect copyright of said second description (Columns 59-60, lines 62-6); and
  - cc. describing a flag which, indicates that the copyright of said second description is protected (Column 9, lines 19-32), and information of a second protect canceling tool for canceling the protection of the copyright of said second description.
19. As to claim 8, Ginter shows:
- dd. A content server **600** comprising:
  - ee. a content processor **500** which processes content to protect copyright of the content;

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- ff. a use condition generator **300** which generates use conditions of the content;
  - gg. a describer **604** which describes a first digital item **880**,
  - hh. said first digital item containing the content (Figure 20, within container 300) or an address of the content and being able to contain other digital items defined therein (Figure 20, Content 812a-n);
  - ii. a packaging unit **602** which packages said first digital item (in container **300**); and
  - jj. a deliverer **628** which delivers said first or second digital item packaged by said packaging unit to a user terminal **112**;
  - kk. wherein said describer describes both of a first description regarding processing the content to protect the copyright of the content (Columns 14-15, lines 49-9) and a second description regarding the use conditions (Figure 5B, **308**, Limitations On Activities) in said first digital item.
20. Ginter does not expressly show:
- The first digital item is described in the form of Digital Item Declaration.
21. However, Chang teaches a digital item in Digital Item Definition Language (“DIDL”) ([0013] and Figure 1) containing a Declaration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ginter to substitute the DIDL structure for the generic structure of Ginter in order to “provide a method for configuring a digital item using the condition that corresponds to a user determined precedence of the selection” [0027].

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22. As to claims 9 and 10, the describing of a flag and information of a first or second product cancelling tool are non-functional, as the data is not positively shown as being used. Therefore, the method where multiple pieces of information can be stored as shown in reference to claim 1, also renders this claim obvious.

***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621